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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,905	07/31/2003	William T. Anderson	R11.12-0780	9612
27367	7590	08/24/2005	EXAMINER	
WESTMAN CHAMPLIN & KELLY, P.A. SUITE 1600 - INTERNATIONAL CENTRE 900 SECOND AVENUE SOUTH MINNEAPOLIS, MN 55402-3319				TORRES, MELANIE
ART UNIT		PAPER NUMBER		
		3683		

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/631,905  
Filing Date: July 31, 2003  
Appellant(s): ANDERSON, WILLIAM T.

Christopher R. Christenson  
For Appellant

**EXAMINER'S ANSWER**

**MAILED**

AUG 24 2005

**GROUP 3600**

This is in response to the appeal brief filed June 8, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

US 6,384,721 Paieli

US 6,366,201 Hanisko

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paielli in view of Hanisko.

Re claims 1-13, Paielli teaches a brake pad for an vehicle, the brake pad comprising: a pad portion (42) disposed on the base member, the pad portion being constructed from a substantially non-conductive dielectric material; and first pair of capacitive plates (24, 26) disposed in the pad portion and arranged such that wear of the pad portion changes the capacitance between the first pair of capacitive plates. However, Paielli does not teach a base member. Hanisko teaches a brake pad for a vehicle comprising a base member (15). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a base member in the invention of Paielli to provide additional support of the brake lining as is well known in the art.

Re claims 2 and 3, Paielli teaches wherein the pad portion is adapted to contact either a drum rotor or a disc rotor. (Column 2, lines 49-55)

Re claims 7-10, Paielli teaches wherein a second pair of capacitance plates (C3, C4) disposed within the pad portion and arranged such that capacitance between the second pair does not change with wear of the pad portion. (Column 3, lines 30-38)

#### **(10) Response to Argument**

Applicant argues that the “pad portion” is disclosed in the cited references. It is unclear to the examiner how this is possible since both Paielli and Hanisko teach pads (42 and 11 respectively).

Applicant argues that all the limitations are not disclosed in the prior art references, specifically that the capacitive plates of Paielli are not in contact with the brake pad. As previously discussed, the examiner is broadly interpreting the insulating portion (22, 28) of Paielli as a portion of the brake pad. Since the base member is a portion of the pad and is worn along with the pad, the interpretation is valid despite the fact that they are two elements. There is no limitation to preclude the interpretation of the base member (22) as a portion of the pad. As such, the base member is “disposed in and in contact with the pad portion.” Alternatively, the brake pad can be interpreted as the claimed “base member” and the body (22) can be interpreted as the claimed “pad portion.”

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Applicant further argues the obviousness of the rejection. The arguments above are drawn to the base reference (Paielli) only and have no relevance with respect to the combination. The combination is merely applied as a teaching of the claimed "base member" or a brake shoe 15. The examiner maintains that brake shoes are extremely well known in the art for providing support and strength to brake pads. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Although applicant argues that the instant invention provides benefits, there is no claimed limitation which would overcome the rejection above. Applicant argues that making the pad portion integral is novel. However, it has been held that forming in one piece an article which has been formerly been formed in two pieces and put together involves only routine skill in the art. (See *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965), MPEP 2144.04 V.B., and *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893))

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MT

*Melanie Jones*  
8/16/05

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Conferees:

CM CM  
RS MM